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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/586,321 | 07/14/2006 | Frans Johan Sarnecki | 19790-012US1 | 1840 |
| 26191 7590 03/31/2009 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | | |
| EXAMINER ANDERSON, JERRY W | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1794 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 03/31/2009 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/586,321

Applicant(s)

SARNEEL ET AL.

Examiner

JERRY W. ANDERSON

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed 1/26/2009 has been entered. Claims 1-9 and 11-22 are pending. No Claims have been amended and no claims have been added.
2. The specification has been amended to incorporate trademarks where applicable. The objection to the specification has been withdrawn
3. New drawings have been submitted. The objection to the drawings has been withdrawn.

Claim Rejections - 35 USC § 103

1. Text of those sections not included in this action can be found in a previous action.
2. **Claims 1-2, 4-5, 7-9, 11-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lenchin*, J.M., in view of *Evans*, et al., and further in view of *Fruin*, J.C. for the reasons stated in the Office action mailed 10/27/2008.
3. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Lenchin*, J.M., in view of *Evans*, et al., in view of *Fruin*, J.C., and further in view of *Sarneel*, F.J. for the reasons stated in the Office Action mailed 10/27/2008.

Response to Arguments

4. Applicant's arguments filed 1/26/2009 have been fully considered but they are not persuasive.

5. As to the statement that Lenchin teaches the use of starch modified with 1-octenylsuccinic anhydride, in paragraph 7 on page 3 of the Office action, this was a typographical error and the examiner apologizes for the oversight.

6. First, Applicant states that the art teaches away from combining. As to the applicant's reference to Lenchin's statement regarding the difficulties of using known batter mixes in microwaves, (lines 24-29, col. 2, '607) Lenchin is not teaching away from combining of previous art but is stating the problem that Lenchin seeks to solve. Lenchin also used his formulation for baking and microwaving. Lenchin discusses the use of modified starches, to wit: oxidized treated with oxidizing agents, or chemically derivatized by means of esterification or etherification reactions. (lines 42-45, col., 4, lines 2-4, col. 5, '607) Lenchin clearly contemplated the use of the modified starches used in the instant application. One of ordinary skill in the art would naturally look at the available art to find modified starches that would perform better than natural unmodified starches in the solution of the problems of adherence and the preservation of appearance.

7. Second, the applicant asserts that Examiner improperly used the applicant's specification as a hind sight guide, (paragraph 3, pg 8) and that Lenchin does not use any of the starches listed in the instant application. However, Lenchin does use modified starches such as Dextrins, (tables II - IV) a mildly oxidized starch, (table I). These experiments of Lenchin show that he is seeking to use an effective modified starch with good emulsive powers that provides a crispy coating. The incorporation of

the known modified starches of Fruin and Evans, with their known properties, would be within the stated permissible changes.

8. Third the applicant states, incorrectly, that Lenchin includes only a single example of the use of a modified starch. Lenchin as stated before, tries two modified starches, at different levels, Dextrins, listed in Tables II-V, a mildly oxidized and derivatized starch in Tables 1& II. Lenchin discloses that his invention encompasses the use of modified starches. One of ordinary skill in the art would go to the available art to find other sources of modified starches that would be applicable. As before the motive to combining, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lenchin has clearly foreseen that chemically modified starch would be amenable to his process.

9. Fourth Lenchin had already reviewed the prior art listed by the applicant and found them wanting. It was not necessary to determine whether said prior art should be considered by Lenchin when he had stated the problems of using said prior art.

10. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JERRY W. ANDERSON whose telephone number is (571)270-3734. The examiner can normally be reached on 7 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jwa

/KEITH D. HENDRICKS/

Supervisory Patent Examiner, Art Unit 1794